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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/547,284

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Hiroshi Satomi

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03/14/2006

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/547,284	Applicant(s) SATOMI ET AL.	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 109,111-115 and 117-121 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 109,111-115 and 117-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/23/05, 1/25/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 109, 111-115, and 117-121 are pending. Claims 109, 111, 115, 117, and 121 have been amended and claims 110 and 116 have been cancelled in this communication filed 12/23/05 entered as Response After Non-Final Action.
2. The IDS filed 12/23/05 and 1/25/06 have been considered and entered.
3. The 35 USC 112, second paragraph rejection of claims 110 and 116 has been overcome by Applicants' cancellation of claims 110 and 116. Therefore, the rejection is considered moot. The Amendment to claim 115 has overcome the 35 USC 112, second paragraph rejection for claim 115 and claims 117-120 which depend there from and is hereby withdrawn.
4. The 35 USC 101 Rejection for pending claims 109, 111-115, and 117-121 is hereby withdrawn in view of the recent court decision of *In re Lundgren*. The 35 USC 101 Rejection for claims 110 and 116 is considered moot since they have been cancelled.

Abstract

5. The abstract of the disclosure is objected to because the Fig. 1 in parenthesis need to be deleted in the heading entitled "ABSTRACT OF THE DISCLOSURE". Correction is required. See MPEP § 608.01(b).

Specification

6. The Specification is objected to because the Specification is replete with grammatical and misspelled errors. For example, page 3, lines 15, 16, and 25 read "... , ... side also enables to ... to the user. According ..., upon determining that the another

information". These lines would be better read as "... side also enables to ... to the user. According ..., upon determining the other information". Page 4, lines 1, 2, 25, and 26 have a similar problem with the usage of the word "another" which should be "other". These are only a few of the grammatical and spelling errors. The Specification appears to be a literal translation from a foreign application and not acceptable for US examination practice.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 109, 111-115, and 117-121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, claims 109, 115, and 121 recite "inputting code" then go on to recite "retrieving" and "searching a first database for first information corresponding to the input code and extracting the

first information and its properties". It is not understood what kind of code is being input. Then the claims continue by reciting "determining a layout for printing the first information extracted ... on a paper sheet; ...; preparing a plurality of layout examples of the plurality of pieces ...". It is unclear from reading the claims and the Specification what Applicants' are trying to invent. Are Applicants' inputting a password or a unique identifier (inputting code) and preparing layouts for advertisements for printing?

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 109, 115, and 121 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are "after the first database is searched for information" nothing else is being done with the first database then the claim goes to "searching a second database for second information" and nothing else is done with the second database in the claim limitations. There should be at least another step for the first database and the second database. The metes and bounds of the claims cannot be determined. The invention is being obscured as written in the claim language and the Specification. Applicants' are respectfully requested to particularly point out the invention and the inventive concept so it can be understood.

Inquiries

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
Primary Examiner
February 27, 2006